

REMARKS

Reconsideration and allowance of the subject application are respectfully requested. By this Amendment, Applicant has amended claims 82-84 and has added new claim 104. Therefore, claims 1-104 are now pending in the application. Applicant respectfully submits that no new matter is added.

Claim Rejections - 35 U.S.C. § 112

Claims 82-84 are rejected under 35 U.S.C. § 112, first paragraph, for the reasons set forth on pages 2 and 3 of the Office Action. Applicant has amended claims 82, 83 and 84 to correct the informalities, and therefore, respectfully requests withdrawal of the rejection.

Claim Rejections - 35 U.S.C. § 103

Claims 1-4, 6-29, 31-54 and 56-103 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Loveman et al. (US 6,211,869, "Loveman") in view of Clarin et al. (US 6,414,725, "Clarin").

A. No Combination of The Applied References Teaches or Suggests All the Features of the Independent Claims.

Claim 1 recites, inter alia, "reformatting the received content into content having a first format... second format... and... third format with a lowest resolution." The Examiner now seems to be admitting that the primary reference Loveman fails to teach or suggest the noted

features of claim 1 (See Office Action: page 5, “Loveman, however does not explicitly describe a third format of the content, the third format having a lowest resolution and being stored in the fast access storage, as is claimed.”). However, the Examiner takes official notice that it was “notoriously well-known in the art of video editing to implement such clips as thumbnails, which have size and resolution that is lower than the content that they represent” (See Office Action: page 5). It appears that the Examiner is attempting to make up for the admitted deficiencies of Loveman by taking such official notice. However, Applicant respectfully submits that even with the official notice, the noted features of claim 1 are not taught or suggested.

Claim 1 unambiguously recites “reformatting the received content into content having a first format... second format... and... third format with a lowest resolution.” That is, claim 1 requires *reformatting* a received content into *three* separate formats of differing resolution scale, one of which is the content “having a third format with a lowest resolution.” As such, in order for the Examiner to render a valid prima facie case of obviousness under 35 U.S.C. § 103 (a), it is not enough to merely note the alleged common use of the thumbnails through the official notice. Rather, the Examiner must account for the plain language of claim 1 which recites “reformatting the received content into content having a first format... second format... and... third format with a lowest resolution.”

Even with the alleged common use of thumbnails at the time of the invention¹, Applicant respectfully submits that the assertions advanced by the Examiner on page 6 of the Office Action are not tenable. Without further evidence or citation of a specific prior art reference, the

¹ Noted by the Examiner through the official notice.

Examiner merely asserts that “[t]o generate such thumbnails, it is understood that the above-described ingest system of Loveman additionally reformats the initial content into content having a third format with a lowest resolution, i.e. the resolution for the thumbnails...” (See Office Action: page 6). However, even assuming *arguendo* the alleged well-known use of thumbnails at the time of the invention, there are many different ways in which one ordinarily skilled in the art may have chosen to implement the use of thumbnails in a video editing system (e.g., the content having a third format may just as well be provided to the ingest system as an independent content without it being “reformatted” from an initial format). The Examiner simply fails to rely on any evidence or support on the record teaching or suggesting the specific recited features of claim 1, as noted above.

The relevant portion of the MPEP clearly states that “[o]fficial notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art are capable of instant and unquestionable demonstration as being well-known” (See MPEP § 2144.03 A.). Further, the section goes on to state, “[i]t would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known” (*Id.*). In the current rejections, Applicant respectfully submits that the alleged common use of thumbnails noted through the Examiner’s official notice by itself fails to teach or suggest the recited features of claim 1 in an “instant and unquestionable” manner. Further, in an instance where Applicant traverses the Examiner’s official notice, the Examiner must produce documentary evidence (See MPEP § 2144.03 C.).

Further, claim 1 also recites, *inter alia*, “storage for storing the lower resolution content and lowest resolution content in a fast access storage.” It appears again that the Examiner is attempting to make up for the admitted deficiencies of Loveman through the official notice taken in the current Office Action. Under the rationale analogous to those discussed above, Applicant respectfully submits that even with the official notice, the noted “*storage* for storing the lower resolution content and lowest resolution content in a fast access storage” is not taught or suggested.

As stated in MPEP § 2144.03 A.², without further evidence or support, the Examiner cannot reasonably assert that the alleged common use of such thumbnails necessarily teaches the specific structure of “storage for storing the lower resolution content and lowest resolution content in a fast access storage,” as recited in claim 1. As there are many different ways by which one ordinarily skilled at the time of the invention could have implemented storage for thumbnails in a video editing system, and the Examiner fails to produce any evidence teaching or suggesting the specific structure of “storage” recited in claim 1, Applicant respectfully submits that the Examiner has failed to render a valid *prima facie* case of obviousness under 35 U.S.C. § 103 (a).

² “As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be ‘capable of such instant and unquestionable demonstration as to defy dispute’ (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 USPQ 6 (CCPA 1961)).”

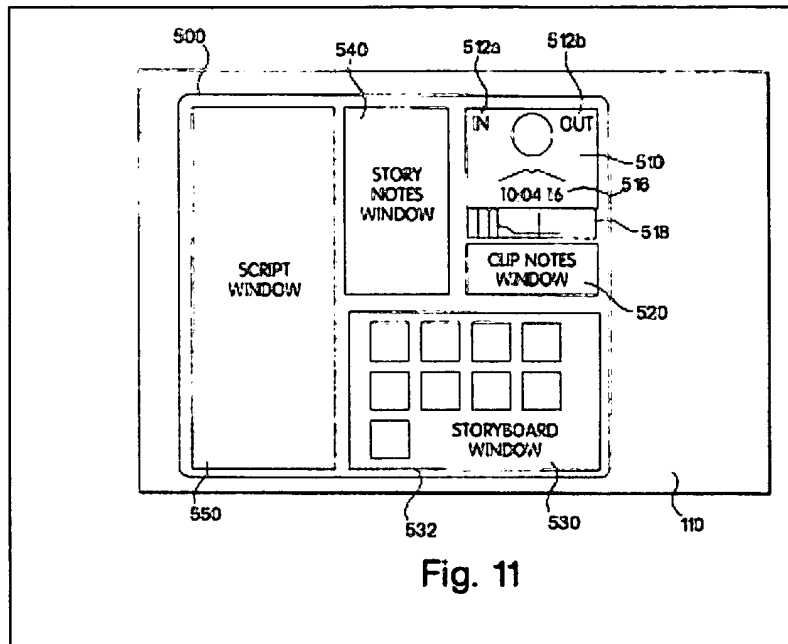
In view of all the foregoing, Applicant respectfully submits that such official notice combined with the system described in Loveman still fails to teach or suggest at least the “ingest system” and the “storage” recited in claim 1.

**B. One of Ordinary Skill Would Not Have Modified Loveman to Incorporate the Use of
Thumbnails**

As for the motivation to combine the editing system described in Loveman with the alleged common use of thumbnails noted through the official notice, the Examiner states in a single conclusionary sentence that “[o]ne would have been motivated to use such thumbnails because of their widespread use and because they are standard means for representing video data, as is known in the art” (See Office Action: page 5). Applicant respectfully disagrees and submits that the Examiner fails to identify the requisite suggestion or incentive that would have motivated an artisan ordinarily skilled in the art to modify a reference or to combine references in the manner proposed by the Examiner (See: *In re Fine*, 837 F.2d 1071, 1074 (Fed. Cir. 1988)).

“In determining the propriety of the Patent Office case for obviousness in the first instance, it is necessary to ascertain whether or not the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the reference before him to make the proposed substitution, combination, or other modification” (See MPEP § 2143.01). The prior art must be considered in its entirety, including disclosures that teach away from the claims (See MPEP §§ 2141.02, 2145(X)(D)).

Applicant further points out that the modifications to Loveman proposed by the Examiner “cannot change the principle of operation of the primary reference or render the reference inoperable for its intended purpose” (See MPEP §§ 2143.01, 2145(III) and (X)(D)).



As shown to the left in Fig. 11 of Loveman, Loveman describes a user interface 500 with a viewing window 510 which “displays a low resolution video component of low resolution media data to be viewed and edited” (See Loveman: col. 18, lines 11-13).

In addition, the user interface 500 also provides for a storyboard window 530, which provides an area where a user can lay out a sequence of clips 532 of the low resolution video. These clips, as cited by the Examiner, show a frame of the respective clip of the low resolution video for identification (See Loveman: col. 18, lines 47-52; Office Action: page 5).

As such, since these clips 532 described in Loveman appear to be depicted within a smaller area than the low resolution content and only comprise a single frame provided for

smaller screen,³ Applicant respectfully submits that modifying Loveman to additionally provide for the use of thumbnails, as suggested by the Examiner, would be highly redundant. Typically, thumbnails of a lower resolution are provided for displaying representative images of a higher resolution. Applicant respectfully submits that incorporating the additional feature of displaying thumbnails into the user interface 500 of Loveman would likely render the storyboard window 530 displaying clips 532 redundant and thereby moot.

Therefore, in view of the foregoing, Applicant respectfully submits that one ordinarily skilled in the art would not have been motivated to modify the system of Loveman to additionally incorporate the feature of displaying thumbnails.

C. One of Ordinary Skill Would Not Have Modified Loveman in view of Clarin

Claim 1 recites, *inter alia*, “an edit station for selecting a portion of content from the lower resolution content using a browser.” The Examiner again admits that Loveman fails to teach or suggest such feature of claim 1. However, the Examiner continues to assert that the secondary reference Clarin makes up for the admitted deficiency of Loveman. Applicant respectfully disagrees, and submits that one of ordinary skill would not have been motivated to modify Loveman in view of Clarin as the Examiner alleges.

Loveman generally describes an editing system utilizing particular client software that provides many different functions (See Loveman: col. 13, lines 41-44). However, Loveman

³ Applicant respectfully notes that the Examiner has advanced such statement on pages 5-6 of the Final Office Action dated May 13, 2005.

provides no indication that this client software is in any way deficient with respect to these required features. Therefore, in order to support the current rejection, Clarin must teach both a browser capable of use within the Loveman system, and the requisite motivation to modify Loveman to use such a browser therein.

However, Clarin is deficient in this regard, as Clarin fails to teach or suggest that its browser would be an improvement over the particular client software used in Loveman. Further, Clarin is simply silent regarding whether its browser is capable of performing all of the functions required by Loveman's client software (*e.g.*, storyboard creation). Therefore, Applicant respectfully submits that one ordinarily skilled in the art would not have been motivated to combine Loveman with Clarin in the manner suggested by the Examiner.

In view of the foregoing, Applicant respectfully submits that claim 1 is patentable over Loveman in view of the official notice and Clarin. With respect to independent claims 26 and 51, Applicant respectfully submits that the claims are patentable under the rationale analogous to those discussed with respect to claim 1.

D. Independent Claims 22, 47 and 72 Are Patentable Over The Applied References

With respect to independent claims 22, 47 and 72, Applicant respectfully submits that the proffered combination of Loveman and Clarin fails to teach or suggest "storing content in a low resolution format and content in a lowest resolution format in a fast access storage and storing content in a high resolution format in a high capacity storage, wherein the fast access storage is accessible more quickly than the high capacity storage," for at least the reasons discussed above

with respect to claims 1, 26 and 51 (*i.e.*, the failure of the applied references⁴ to teach or suggest the presence of “a low resolution format,” “a lowest resolution format,” and “a high resolution format”).

E. Independent Claims 24, 49 and 74 Are Patentable Over The Applied References

With respect to independent claims 24, 49 and 74, Applicant respectfully submits that the proffered combination of Loveman and Clarin fails to teach or suggest “server software enabling selection of a portion of low resolution content and lowest resolution content from a first stored file in a fast access storage accessible to a server” (claim 24) or “selecting a portion of lowest resolution content and low resolution content from a first stored file in a fast access storage using a browser” (claims 49 and 74), for at least the reasons discussed above with respect to claims 1, 26 and 51 (*i.e.*, the failure of the applied references⁵ to teach or suggest the presence of “a low resolution format,” “a lowest resolution format,” and “a high resolution format”).

F. Independent Claims 76, 77 and 78 Are Patentable Over The Applied References

With respect to independent claims 76, 77 and 78, Applicant respectfully submits that the proffered combination of Loveman and Clarin fails to teach or suggest “receiving content in an initial format and reformatting the received content into three content formats, each having a

⁴ The Examiner merely uses the two prior art references (Loveman and Clarin) without taking an official notice as in the case of claim 1 in rendering rejections of claims 22, 47 and 72 (See Office Action: page 12). However, the Examiner has already admitted to the deficiency of Loveman regarding the use of the “lowest resolution format.”

⁵ The Examiner again only relies on Loveman and Clarin without taking official notice to make up for the admitted deficiency of Loveman.

different resolution,” for at least the reasons discussed above with respect to claims 1, 26 and 51 (*i.e.*, the failure of the applied references⁶ to teach or suggest “three content formats”).

Accordingly, Applicant respectfully submits that independent claims 1, 22, 24, 26, 47, 49, 51, 72, 74, 76, 77, and 78 are patentable over the applied references. Further, Applicant respectfully submits that dependent claims 2-4, 6-21, 23, 25, 27-29, 31-46, 48, 50, 52-54, 56-71, 73, 75, 79-81, 98-102 and 103 are allowable at least by virtue of their dependency.

G. Claims 5, 30 and 55

Claims 5, 30 and 55 are rejected under 35 U.S.C. § 103(a) as being unpatentable over the combination of Loveman in view of Clarin and further in view of the “VideoUniversity.com” website (“VideoUniversity”). Applicant respectfully submits that dependent claims 5, 30 and 55 are allowable at least by virtue of their dependency from independent claims 1, 26 and 51, respectively. Further, VideoUniversity.com does not make up for the deficiencies of Loveman and Clarin.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the

⁶ The Examiner again only relies on Loveman and Clarin without taking official notice to make up for the admitted deficiency of Loveman.


Amendment Under 37 C.F.R. § 1.111
U.S. Application No. 09/829,584

**Attorney Docket No.: A8692/
SVL920010023US1**

Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

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